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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,657	11/29/2001	Charles Raymond Degenhardt	8375D	6277

27752 7590 02/11/2003

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EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,657

Applicant(s)

DEGENHARDT ET AL.

Examiner

RITA J. DESAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17, 19 and 22-25 is/are rejected.
- 7) ☒ Claim(s) 18, 20, 21 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

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DETAILED ACTION

Applicants have cancelled claims 1-16. They have added new claims 17-26.

Applicants have amended the claims to the restricted group, IV .

The objection to claims 12 and 14 for improper dependency has been withdrawn since applicants have cancelled the claims .

Claim Rejections - 35 USC § 112

The claims 1 and 5 rejected under 35 USC 112 under first para has been withdrawn since applicants amendment has deleted some more carbocyclic , hetero rings.

The applicants claims will be considered to the scope and description of these groups , limited to the description in the specifications.

The claims 3 and 6 (now new claims 17 and 23) rejected under 35 USC 112 second para as being indefinite still stands.

The applicants have deleted one term “about’ but the definition of a), b), c), d), and t still have “about “, which makes the term indefinite. The meets and bounds of the claim is unclear.

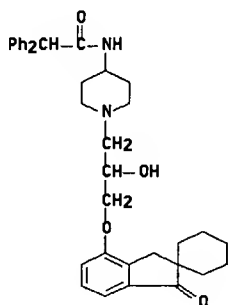
The values cannot be a fraction.

Applicants can overcome this by deleting the term about from these definitions.

Claim Rejections - 35 USC § 102

The rejection of the claims 1-6 and 9 (now claims 17,19,22,23,24 and 25) under 35 USC 102 still stands. The reference discloses the compounds of the invention. See

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Spiro[cyclohexane-1,2'-(2H)indene], benzeneacetamide.

Compound 56 reads on claim 1 compounds, wherein x is 0, D1 is NH, D2 is C=O, R2 is a biphenyl of the group as given in claim 6, R1 is hydrogen, or hydroxy, D4 is CHR1, t is 2, D5 is OR6, and R6 is a substituted hydrocarbon group, or a substituted aromatic group according to the definitions given in the specifications.

Since even though the prior art has a) and b) to be 1, the claims reads about 2 and 1 is about 2 since you cannot have any fraction groups.

And also even if applicants exclude a) and b) to be 1, then also a) and b) is a 2 is a homolog differing by just one methylene group, and homologs would be obvious.

Thus the rejection still stands.

Conclusion

Thus claims 17,19,22,23,24 and 25 stand rejected and claims 18, 20, 21 and 26 are objected to.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A handwritten signature in cursive script, appearing to read 'R. Desai', with a horizontal line underneath.

R.D.

February 7, 2003